

REMARKS

Claims 1-23 are pending in the application. In the Office action dated October 29, 2004, claims 1-13 and 18-22 are allowed, claims 14-17 and 23 are objected to, claims 14-17 and 23 are rejected under U.S.C. § 112, second paragraph, as being indefinite; and claims 14-16 are rejected under 35 U.S.C. § 102(b) as being anticipated by Maki (U.S. Patent No. 5,639,522). Responsive to the Office action, claims 14-16 are amended, and new claims 24-28 are added. In view of the above amendments and the remarks that follow, Applicant respectfully requests reconsideration of the rejected claims under 37 C.F.R. § 1.111.

Objections to the claims

Claims 14-17 and 23 are objected to because the Examiner considers the claims to be inconsistent in specifying the claimed subject matter. Without acknowledging the propriety of the objection, Applicant takes this opportunity to amend claim 14 as suggested by the Examiner. In particular, Claims 14-16 are amended to clearly recite a fastener that is capable of being inserted into a housing space inside a fastener holder. In view of the above amendments, Applicant respectfully suggests that, as amended, claims 14-16 clearly recite a fastener, and not the combination of the fastener with a fastener holder, and therefore requests the withdrawal of the objection to claims 14-16.

Rejections under 35 U.S.C. § 112

Claims 14-17 and 23 are rejected under 35 U.S.C. § 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner indicates that the claim elements "the engage-and-stop portion" and "the lateral walls" do not have antecedent basis in the claim. Applicants have amended claim 14 so that the "engage-and-stop portions" and "lateral walls" do not require antecedent basis.

In view of the above amendments, Applicant respectfully requests the withdrawal of the rejection of claim 14 under 35 U.S.C. § 112, second paragraph.

Rejections under 35 USC § 102

Claims 14-16 are rejected under 35 U.S.C. § 102(b) as being anticipated by Maki et al. (U.S. Patent No. 5,639,522). In particular, the Examiner indicates that Maki et al. teaches a base plate (152 of Maki et al.), an engaging portion (154) that projects upright from the base plate, a pair of extending elastic pieces (156) whose ends are free, and that there are protruding portions formed to the elastic pieces. As a result, the Examiner suggests that Maki et al. teaches all of the structural elements recited in claim 14, and is considered capable of performing all of the functions recited in the claims.

Without acknowledging the propriety of the rejection, Applicant has amended claim 14 to recite that the pair of extending elastic pieces are provided on and extending from the base plate, that the base plate and the elastic pieces are capable of being inserted into a housing space inside the fastener holder via an opening, and that the protruding portions on the elastic pieces enable the claimed fastener to engage with a fastener holder in a releasable manner.

With particular reference to Figures 14 and 15 of Maki et al., Applicant notes that the engaging sections of the Maki et al. fastener (156) are never inserted into a housing space inside the corresponding fastener holder (140) even when sections 156 are taken as elastic pieces as suggested by the Examiner. In fact the engaging sections of Maki et al. as identified by the Examiner are inserted into body panel 100 of the automobile. Further, Maki et al. fail to disclose a fastener having elastic pieces with protruding portions formed on the elastic pieces that are capable of engaging a fastener holder in a releasable manner on the inside of the housing space inside the fastener holder.

The Examiner has indicated that Maki teaches every structural element of the fastener, and is therefore considered to be capable of performing the same functions as the fastener of claim 14. Applicant respectfully disagrees. The fastener of claim 14 includes a pair of extending elastic pieces having protruding portions, where the protruding portions are configured to engage a fastener holder. The Examiner has indicated that because Maki et al. discloses a fastener having elastic pieces 156, that therefore Maki discloses the claimed fastener. However, engaging section 156 of clip 150 of Maki et al. is configured to be inserted into engaging hole 102 of body panel 100, and is not configured to engage a fastener holder. The Examiner is not permitted to ignore the plain teaching of the Maki et al. reference in order to construct a rejection. In order to anticipate the claimed subject matter, the cited reference must set forth each and every element of the claim, and those elements must be arranged as required by the claim (see MPEP § 2131).

Additionally, the Examiner suggests that the fastener of Maki et al. need only

be capable of being releasably mounted to a holder. However, Applicant notes that Maki et al. discloses fasteners that are not releasably mounted to the fastener holder.

With respect to the clip of Fig. 14, Applicant notes that clip 150 is not retained by engagement of elastic pieces present on the base of the fastener. Rather, the clip is retained by claws 148 of the clip holder. As disclosed in the reference at col. 7, lines 43-53, once claws 148 are locked around clip 150, "seat 152 can not be released along the direction of insertion and at the same time the pair of retaining plates 146 are also locked so that the seat 152 can not be released out along the direction intersecting at right angles with the direction of insertion". In other words, the clip of Maki et al. is not engaged with the clip holder in a releasable manner, and therefore does not anticipate the fastener of claim 14.

Similarly with respect to the clip of Fig. 19 of Maki et al., Applicant notes that due to the interaction of engaging claw 257 with engaging section 244 of the clip holder 240, that clip 250 "can not be released along both the direction of insertion of the clip 250 and a direction meeting at right angles with the direction of insertion" (at col. 9, lines 9-16). The clip of Fig. 19 does not include a base plate that engages the fastener holder in a releasable manner, and so does not anticipate the subject matter of claim 14.

The clip of Fig. 21 of Maki et al. includes claw 357, which, when engaged with engaging section 34, renders clip 350 "unreleasable along both the direction of insertion of the clip 350 and the direction which meets at right angles with the

direction of insertion, thereby securely mounting the clip 350 to the clip holder 340" (at col. 10, lines 6-14). Clearly the clip of Fig. 21 does not include a base plate that engages the fastener holder in a releasable manner, and so does not anticipate the subject matter of claim 14. The clip of Fig. 23 is similarly retained.

Applicant suggests that none of the clips of Maki et al. possess the recited features of the fastener of instant claim 14, and that therefore the Maki et al. reference fails to anticipate the claimed subject matter. In view of the above amendments and remarks, Applicant respectfully requests the withdrawal of the rejection of claims 14-16 under 35 U.S.C. § 102.

Allowable Subject Matter

Applicant gratefully acknowledges the indication that claims 1-13 and 18-22 are allowed. The Examiner has indicated that claims 17 and 23 would be allowable if claim 14 were rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph. Applicant suggests that in view of the above amendments and remarks, claims 17 and 23 are also in condition for allowance.

New Claims

Applicant takes this opportunity to add new claims 24-28. Support for new claims 24-28 may be found in claims 14-17 as originally filed, in Figures 1-13 and generally in the specification as filed.

As the above amendments and remarks should be sufficient to overcome the rejections of claims 14-17 and 23, applicant suggests that claims 1-23 are in condition for allowance. Applicant further suggests that the subject matter of new claims 24-28 is allowable for at least the reasons provided above for the subject matter of claims 14-17. A prompt indication of the same is respectfully requested. The Examiner is encouraged to telephone the undersigned if any issues remain that may be resolved by a telephonic interview.

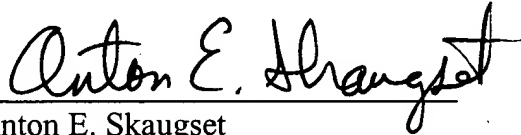
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, Alexandria, Virginia 22313, on January 28, 2005.



Suzanne Lukas-Werner

Respectfully submitted,
KOLISCH HARTWELL, P.C.



Anton E. Skaugset
Customer No. 23581
Registration No. 38,617
of Attorneys for Applicant
520 S.W. Yamhill Street, Suite 200
Portland, Oregon 97204
Telephone: (503) 224-6655
Facsimile: (503) 295-6679